



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re the Application of:

SCHRECK et al.

Serial No.: 09/973,791

Filed: 10/09/2001

Atty. Docket No.: 3123-384

For: "METHOD AND APPARATUS
FOR PROVIDING A USER
SELECTABLE START-UP
CURRENT IN A DISK DRIVE"

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Group Art Unit: 2837

Examiner: Smith, Tyrone W.

PETITION TO
WITHDRAW FINALITY
MPEP § 706.07(C)

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS
BEING DEPOSITED WITH THE UNITED STATES POSTAL
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ADDRESSED TO: COMMISSIONER FOR PATENTS, P.O.
BOX 1450, ALEXANDRIA, VA 22313-1450, ON THIS 31st
DAY OF AUGUST, 2004.


Tejal S. Hansra

Dear Sir:

Applicants hereby petition to withdraw the finality of the Office Action dated March 31, 2004 on the grounds that a claim can not be finally rejected if the Examiner has never stated *ANY* grounds for rejection of such claim. The facts are as follows:

1. In the Office Action of July 31, 2003 (Paper No. 5), the Examiner failed to state any grounds, whatsoever, for rejecting Claims 7 and 8. (The Examiner did include an *objection* to Claim 7, which Applicants addressed, but did not state grounds for his *rejection* of Claim 7. No grounds were stated for the Examiner's rejection of Claim 8). There was no indication of whether Claims 7 and 8 were rejected on the basis of 35 U.S.C. 102, 103, 112 or any other basis.

Furthermore, there was no indication of which, if any, references were being applied against Claims 7 and 8.

2. In the Amendment filed December 1, 2003, Applicants expressly pointed out to the Examiner that he had failed to address Claims 7 and 8 in the “Detailed Action”, and thus had failed to provide a *prima facie* case for rejection of Claims 7 and 8. Applicants noted that, because of this deficiency of the Office Action, Applicants could not respond to the rejection of Claims 7 and 8.

3. In the current “Final” Office action, the Examiner (once again) has failed to state any grounds for his rejection of Claims 7 and 8. Specifically, section 2 of the “Detailed Action” of the current Office Action asserts grounds for rejection of Claims 1, 2, 6, 9-12 and 15-17; section 3 asserts grounds for rejection of Claims 18-29 and 31-35; and, section 4 asserts grounds for rejection of Claims 3-5 and 13-14. There was no indication of whether Claims 7 and 8 were rejected on the basis of 35 U.S.C. 102, 103, 112 or any other basis. Furthermore, there was no indication of which, if any, references were being applied against Claims 7 and 8.

In view of the above, the Examiner has failed “[i]n making such final rejection . . . [to] repeat or state all grounds of rejection then considered applicable to the claims in the application, clearly stating the reasons in support thereof” as required by 37 C.F.R. § 1.113.

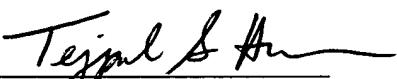
Because Applicants have not been informed whether Claims 7 and 8 are considered anticipated or obvious (or are rejected on some other basis) and because Applicants have not been told which, if any, references are being applied against Claims 7 and 8, Applicants have

been unable to even consider the Examiner's rejection, much less formulate an appropriate response. Accordingly, it is believed improper to issue a *final* rejection of Claims 7 and 8 when the Examiner has not yet even stated a proper (*prima facie*) *non-final* rejection.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the finality of the Office Action of March 31, 2004.

Applicants hereby authorize the Commissioner to charge Deposit Account No. 50-2198 for any fees associated with the filing of this paper.

Respectfully submitted,



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Date: Aug, 31, 2004